

**Judgments of the Supreme Court, the Second Petty Bench**

**Date of the Judgment: 1992.7.17**

**Case Number: 1992(Gyo-Tsu)No.181**

**Main Text of the Judgment:**

The jokoku appeal shall be dismissed.

The jokoku appellant shall owe the cost of the jokoku appeal.

**Reasons:**

Concerning the ground of the jokoku appeal by the representative of the jokoku appellant, MIZUTA Koichi, HANABUSA Masami, HANABUSA Tsuneo, NARITA Keiichi and NAKAMURA Toshio:

According to the summary of the facts duly settled by the original instance, the judgment of the lawsuit for revocation of a patent office decision on the appeal for invalidation revoked the patent office decision on the ground that the patent office decision became erroneous, since the decision was directed towards the invention set forth in item 1 of the scope of the patent claim in the specification before amendment, while the patent office decision on amendment, which was intended to reduce the scope of claims pertaining to the patent, became final while the case was pending.

The judgment further determined that there were no grounds for claims of invalidity of the invention set forth in item 1 of the amended scope of the patent claim in the specification and added this determination in the ground of revocation. In light of this judgment, the effect of the judgment for revocation is limited solely to the reason that the patent office decision was erroneously directed towards the invention before amendment. The subsequent patent office decision with regard to the appeal for invalidation was directed to the invention after amendment according to the effect of the above judgment and decided that there are no grounds for claims of invalidity of the invention set forth in item 1 of the scope of the patent claim after amendment.

However, we consider that this subsequent patent office decision was not decided according to the effect of the above judgment. Accordingly, we deem the ruling of the original instance court to be unlawful in the interpretation and application of law concerning the effect of the prior judgment.

However, the mentioned unlawfulness does not affect the conclusion of the judgment of the original instance court because the original instance court determined that the description in specification after amendment fulfilled the requirement of Article 36 (4) and (5) (the law before revision in accordance with Law No. 41 of 1985). That is, the original instance court determined that the decision by the patent office, that there is no ground for the invalidation of the patent set forth in item 1 of the scope of the patent claim, can be approved. This determination is approved judging from the

evidence listed by the original instance court.

For the reason above-mentioned, we can not find any grounds in the assertion of jokoku appeal which argued that the judgment for revocation of decision with respect to the appeal for invalidation has no binding effect. Accordingly, we cannot adopt the assertion of the jokoku appeal.

In the end, the judgment was rendered in the form of the main text by the unanimous consent of the Justices in accordance with Article 7 of the Administrative Case Procedure Law and Article 401, 95 and 89 of the Code of Civil Procedure.

Presiding Judge, Justice KIZAKI Ryohei, Justice FUJISHIMA Akira, Justice NAKAJIMA Toshijiro, Justice ONISHI Katsuya

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